

REMARKS

Claims 1-11 and 14-20 are pending in this application.

Claims 1-11 and 14-20 have been rejected.

No claims have been allowed.

Claim 6 has been amended as shown above. This amendment places Claim 6 in better condition for allowance or better condition for appeal. As a result, this amendment complies with 37 C.F.R. § 1.116.

Claims 1-11 and 14-20 remain in the case.

Reconsideration of Claims 1-11 and 14-20 is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-6, 10-11, and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,436,886 by McGill ("*McGill*") in view of U.S. Patent No. 6,075,767 by Sakamoto et al. ("*Sakamoto*"). The Office Action also rejects Claims 7-9, 14, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *McGill* and *Sakamoto* in further view of U.S. Patent No. 5,715,237 Akiyoshi ("*Akiyoshi*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP

§ 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

McGill recites an ATM switch using "dual switch plane operation." (*Abstract*). In particular, the switch includes two switch fabrics (SF0, SF1). (*Figure 1; Col. 3, Lines 63-67*).

Asynchronous traffic is sent over one of the switch fabrics, while synchronous traffic is sent over both switch fabrics. (*Col. 4, Lines 34-39*).

Sakamoto recites an “ATM handler” that allows switchovers in a network. (*Abstract*). The ATM handler includes a selector card that selects inputs provided to an ATM switch. (*Col. 2, Lines 5-18*).

The Office Action relies on the “working plane” and “protection plane” of *McGill* as disclosing the “working circuitry” and “protection circuitry” recited in Claim 1. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*). The Applicants note that the “working plane” and the “protection plane” refer to the two switching fabrics of *McGill*. (*Col. 4, Lines 59-64*).

First, the Office Action fails to show that the proposed *McGill-Sakamoto* combination discloses, teaches, or suggests “working circuitry” and “protection circuitry” that are “synchronized to each other” as recited in Claim 1. The Office Action cites three portions of *McGill* as disclosing this element of Claim 1 (*Office Action, Page 3, First paragraph*). The first portion (Figure 9) and the second portion (column 7, lines 20-25) recite how one of the switch fabrics is selected based on bit error rates associated with the switch fabrics. The Office Action fails to explain how selecting a switch fabric based on bit error rates discloses, teaches, or suggests two circuits that are “synchronized to each other” as recited in Claim 1. The third portion (column 6, lines 13-21) recites how a break in a link is handled by the system of *McGill*. The Office Action fails to explain how handling a broken link discloses, teaches, or suggests two circuits that are “synchronized to each other” as recited in Claim 1. As a result, the Office

Action fails to establish that *McGill* discloses, teaches, or suggest “working circuitry” and “protection circuitry” that are “synchronized to each other” as recited in Claim 1.

Second, the Office Action asserts that *McGill* fails to disclose an NxN switch fabric and a cross point switch, which are allegedly recited by *Sakamoto* in the form of the selector card and the ATM switch. (*Office Action, Page 3, Second paragraph – Page 4, First paragraph*). The Office Action then appears to assert that it would be obvious to modify the switch fabrics of *McGill* with the selector card and ATM switch of *Sakamoto*. (*Office Action, Page 4, Second paragraph*). However, the Applicants note that one purpose of *McGill* is to provide a switch that uses multiple switch fabrics to support multiple planes of operation. (*Abstract*). As a result, modifying *McGill* so as to use a single switch would render *McGill* unsuitable for its intended purpose.

Moreover, even if it was permissible to modify *McGill* as suggested in the Office Action, the Office Action relies on the switch fabrics of *McGill* as disclosing the “working circuitry” and “protection circuitry” recited in Claim 1. Because of that, replacing the switch fabrics of *McGill* with the selector card and ATM switch of *Sakamoto* would remove the two elements from *McGill* relied upon in the Office Action to reject Claim 1. According to the logic employed in the Office Action, the proposed combination would replace the “working circuitry” and “protection circuitry” allegedly recited in *McGill* with the “NxN switch fabric” and “cross point switch” allegedly recited in *Sakamoto*. As a result, the proposed *McGill-Sakamoto* combination would fail to disclose, teach, or suggest these elements recited in Claim 1.

For these reasons, the Office Action fails to show that the proposed *McGill-Sakamoto* combination discloses, teaches, or suggests the Applicants' invention as recited in Claim 1 (and Claims 2-11 and 14-18 depending from Claim 1). For similar reasons, the Office Action fails to show that the proposed *McGill-Sakamoto* combination discloses, teaches, or suggests the Applicants' invention as recited in Claim 19 (and Claim 20 depending from Claim 19).

Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection and full allowance of Claims 1-11 and 14-20.

II. CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

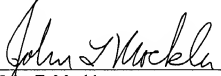
For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at the email address indicated below.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Davis Munck Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for this extension to Deposit Account No. 50-0208.

Respectfully submitted,

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